IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Joseph Seamon	Examiner: Hanh Thai
Serial No.:	09/733,767	Group Art Unit: 2163
Filed:	December 8, 2000	Docket: 2043.098US1
Title:	METHOD AND SYSTEM FOR CATEGORIZING ITEMS IN BOTH ACTUAL AND VIRTUAL CATEGORIES	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

§101 Rejection of the Claims

Claims 1, 3-6, 8-12, 14-18 and 20-29 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant respectfully submits that claims 1, 3-6, 8-12, 14-18 and 20-29 should not be rejected under 35 U.S.C. § 101 for the reason that the claimed inventions of independent claims 1, 14, 20, 28 and 29 achieve a final result that is concrete, tangible and useful.

> A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result.

AT&T v. Excel Communications, Inc., 172 F.3d

> "In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

USPTO OG Notices: 22 November 2005, Section IV, 2, b. Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility.

> Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again.

Id. citing In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)

> The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a Sec. 101 judicial exception, in that the process claim must set forth a practical application of that Sec. 101 judicial exception to produce a real-world result (emphasis added).

Id. citing Benson, 409 U.S. at 71-72, 175 USPQ at 676-77.

Contrary to the Examiner's assertion, claims 1, 3-6, 8-12, 14-18 and 20-29 do recite a final result that is useful, tangible, and concrete. Claim 1, for example, recites "a method of constructing category structures within a database" that includes "defining a first structure of categories to classify a data item, the first structure including at least a first category;" "defining a second structure of categories to provide an alternative classification of the data item, the second structure including at least a second category;" "defining the first structure of categories as a first hierarchy of categories in the database and defining the second structure of categories as an alternative second hierarchy of categories in the database, wherein the second category is associated with the first category...and the data item is user-classifiable under the first structure of categories and is not user-classifiable under the second structure of categories."

Claim 1, therefore, covers defining category structures within a database such that a data item is user classifiable under a first hierarchy of categories in the database but not user-classifiable under a second hierarchy of categories in the database. The result is useful because claim 1 recites the definition and relationship of two specific category structures in a database. Certainly defining a category structures in a database is required for subsequent use of the database (e.g., to store and identify data items). In other words, category structures do not come into existence in databases of their own accord – they must be defined. Accordingly, the "defining" required by claim 1 cannot be said to merely be an abstraction in a persons mind, as maintained by the Final Office Action (Paragraph 3, Page 3), because the "defining" in claim 1 results in the construction of two category structures *in a database*, the category structures being independent of the consciousness of a particular person, objectively knowable, and required for

subsequent storage and retrieval of data items both to and from the category structures in the database.

Moreover, Applicant respectfully points out that as of November 22, 2005 the Mental Step Test is not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter (USPTO OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility, Annex 3, Improper Tests for Subject Matter Eligibility"). Accordingly, the Final Office Action's allegation that subject matter of claim 1 is not eligible subject matter for the reason that the "defining" of claim 1 "may simply be defining in [a] person's mind" (Final Office Action, Paragraph 3, Page 3) is improper. Applicant respectfully requests the Examiner to reconsider the present rejection without reliance on the Mental Step Test.

The result achieved by claim 1 is practical because the definition of category structures in a database is prerequisite to using the category structures to classify and/or identify a data item. Merely for example, the present application describes an embodiment in which the "database" of claim 1 may be used:

> The database may, in one exemplary embodiment, support a web site that classifies data items for presentation to a user via a browser.

Application, Paragraph 48.

Certainly the construction of category structures in a database that supports a web site that classifies data items for presentation to a user via browser must be said to be practical. Finally, the "defining," as recited in claim 1, may be repeated and therefore must be said to be concrete.

Claim 14, recites "a method of classifying a data item within a database." The method requires identifying a first category, of a first hierarchy of categories, attributed to a data item and automatically attributing a second category, of a second alternative hierarchy of categories, to the data item, the data item being user-classifiable under the first structure of categories but not user-classifiable under the second structure of categories.

The result of claim 14 is useful because the data item is automatically attributed a second category under a second hierarchy of categories, the data item being user-classifiable under a first hierarchy of categories and automatically attributed a second category under the second hierarchy

of categories. Indeed, the result of claim 14 is useful because a buyer is more likely to locate the data item that is classified under the identified first category and the attributed second category. Consider the following example:

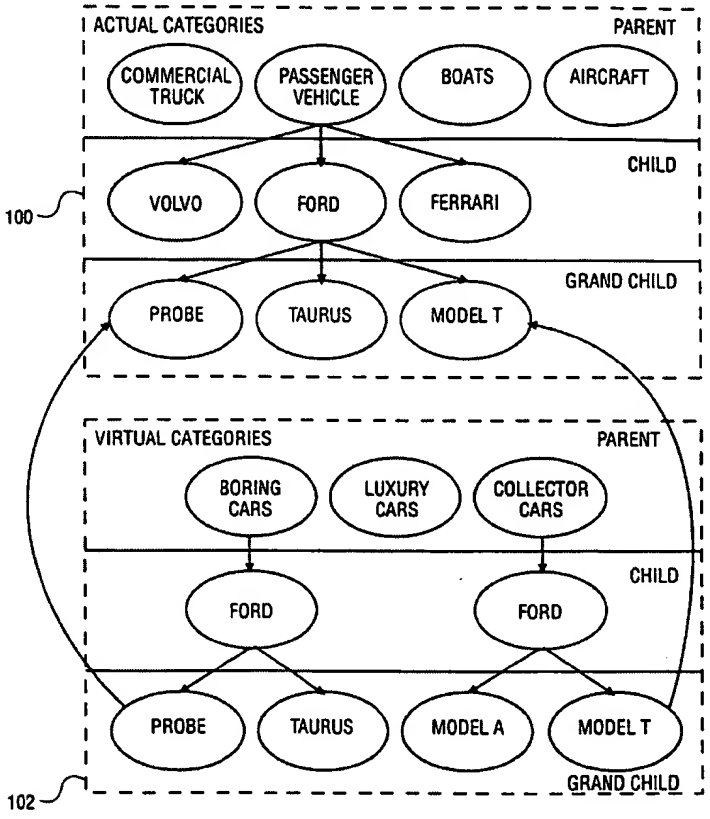

FIG. 6

Merely for example, assume a first category, "Model T," that has been identified as attributed to a data item for a Model T car located under a first hierarchy of categories in the form of "ACTUAL CATEGORIES," as illustrated in Figure 6. Also, assume a second category, "Model T," under a second hierarchy of categories of "VIRTUAL CATEGORIES," as illustrated in Figure 6, is automatically attributed to the same data item. This result may be considered useful because a data item, classified as such, enables a buyer to browse the first hierarchy of categories *or* the second hierarchy of categories to locate the data item for the "Model T." To be sure, the result is useful to at least a buyer and seller who would not have transacted a data item but for the seller's location of the data item classified under the automatically attributed category. For the

same reasons that the result of claim 14 is useful it may also be said to be practical. Finally, the result of claim 14 may be repeated and therefore must be said to be concrete.

The above remarks may also be considered with respect to independent claim 20 that recites a method for facilitating the location of a data item within a database.

Claims 3-6 and 8-12, depend on independent claim 1; claims 15-18 depend on independent claim 14; and claims 21-27 depend on independent claim 20. If an independent claim is patentable subject matter under 35 U.S.C. § 101 then, any claim depending there from also includes patentable subject matter and rejection of claims 3-6, 8-12, 15-18 and 21-27 under 35 U.S.C. § 101 is also addressed by the above remarks.

Applicant respectfully submits that claims 1, 3-6, 8-12, 14-18 and 20-29 should not be rejected under 35 U.S.C. § 101 for the reason that the claimed inventions of independent claims 1, 14, 20, 28 and 29 achieves a final result that is concrete, tangible and useful. Accordingly, the Examiner has not met his initial burden for establishing a *prima facie* case of unpatentability. For at least the foregoing reasons, the rejection of claims 1, 3-6, 8-12, 14-18 and 20-29 under 35 U.S.C. § 101 is without basis and should be withdrawn.

CONCLUSION

Applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4046 to discuss the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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Date 12.11.2006 By Mark R. Vatuone
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 day of December 2006.

Name Peter Rebaffoni Signature